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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER	
RYAN, PATRICK A	

ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/675,468	KARAOGUZ ET AL.	
	Examiner	Art Unit	
	PATRICK A. RYAN	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is made in response to Applicant's "Reply to Office Action of October 3, 2007" received January 3, 2008. Applicant has amended Claims 1-21, 23, 30, and 31 as of January 3, 2008. As amended, Claims 1-31 are presented for examination.

2. Applicant has amended the specification Paragraphs [01-02] in order to provide US Application serial numbers for applications filed September 8, 2003, September 11, 2003, and September 30, 2003.

3. Applicant has amended the specification Paragraphs [36-37] to provide support "Internet-based media exchange infrastructure 104" as shown in Figure 1A. In view of this amendment, the objection to Figure 1A under 37 CFR 1.83(a) has been withdrawn.

Response to Arguments

4. Applicant's arguments, see Pages 18-19 of Applicants Reply, filed January 3, 2008, with respect to objection to Specification, have been fully considered and are persuasive. The Examiner acknowledges that the processors stated in Claim 31 are also stated in Paragraph [12] of the Specification. In addition, the Examiner acknowledges Applicant intention of using the terms "media peripheral", "computer", and "storage system" as well known terms in the art of processor technology. The objection to the Specification for failing to provide proper antecedent basis for subject matter of Claim 31 has been withdrawn.

5. Applicant's arguments, see Pages 19-25, filed January 3, 2008, with respect to the rejection of Claims 1-7, 11-17, 21-27, and 31 under 35 USC 102(e) as being anticipated by Boston (US Patent 7,212,730); and the rejection of Claims 8-10, 18-20, and 28-30 as being unpatentable over Boston in view of Oh (US Patent Application Publication 2002/0161713) have been fully considered but they are not persuasive.

The Examiner first notes that Applicant has amended Claims 1, 11, and 21 to read with the added limitation: "displaying a notification of the advertisement on said television, after said receiving of the advertisement" (as stated on Pages 8, 11, and 13 of Applicants Reply), but argues on Page 20 that Boston does not disclose or suggest at least the limitation of "displaying a notification of the advertisement on said television, upon said receiving of the advertisement,". For the purpose of this Office Action, the Examiner will respond in reference to claimed subject matter, as amended on Pages 8, 11, and 13 of Applicants Reply to Office Action.

In regards to Independent Claims 1, 11, and 22, Applicant submits that Boston does not disclose or suggest at least the limitation of "displaying a notification of the advertisement on said television, after said receiving of the advertisement," because (with reference to Applicants reply Page 21) Boston states in Col. 10 Lines 27-34 "that the commercials are played or recorded at a certain time, when the user is viewing or recording a particular channel". Applicant also states that Boston teaches sending a customized edit list that includes commercial identifiers.

Applicant further submits that Boston teaches playing or recording commercials, only when the user is using the DVR, without providing notification of the reception of a

commercial, and references Boston Col. 10 Lines 5-10. Applicant also makes reference to Figure 10 of Boston (Step 1005) "Select Program to Play/Record Using DVR" and (Step 1010) "Retrieve Edit Schedule for Selected Program" and asserts that the custom edit schedule that identifies the commercials is received (Step 1010) only after a program is selected for playback or recording (Step 1005). The Examiner respectfully disagrees.

The Examiner agrees that Boston teaches that the client receives a customized edit schedule (Step 960), but disagrees that Boston teaches receiving the customized edit list only after a program has been selected for playback or recording. The Examiner also submits that Boston teaches the reception of commercials (Step 965) in addition to the customized edit schedule, as supported by Boston Col. 10 Lines 2-4. In reference to Applicant's use of Figure 10, Boston teaches "a flowchart for a DVR client processing downloaded commercials that are referenced in a customized edit schedule", as described in Col. 10 Lines 22-24. The fact that Boston teaches "downloaded commercials" indicates that the commercials are received before the user selects a program for playback or recording because a downloaded item would first need to be stored on the device before the item could be used. Boston's storage of commercials is further illustrated with reference to Figure 11, showing storage device 1180 of Client DVR 1150, which contains Recorded Programs, Program Segments, and Commercials, as described in Col. 11 Lines 53-64.

The Examiner further disagrees that Boston does not teach "displaying a notification of the advertisement". With reference to Figure 14, Boston teaches Guide

1400 in which various programming information is displayed to the user, as disclosed in Col. 13 Lines 36-37. In addition, "Guide window includes the highlighted anchor program that is sponsored by a program sponsor", see highlighted selection 1420 of Figure 14, as described in Col. 13 Lines 37-39; with further reference to Col. 13 Lines 26-35. Furthermore, Guide 1400 may display "certain programs sponsored by a third party sponsor or advertiser", as Boston discloses in Col. 13 Lines 26-28. Therefore, Guide 1400 provides a notification to the user of advertisements that are currently available before the advertisement is displayed. In addition, Boston provides a "highlighted selection" that emphasizes a particular advertisement in the guide.

6. In light of the above reasoning, Applicants arguments regarding "displaying a notification of the advertisement on said television, after said receiving of the advertisement" are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7, 11-17, 21-27, and 31 are rejected under 35 U.S.C 102(e) as being anticipated by Boston et al (US Patent 7,212,730), hereinafter Boston.

9. In reference to claims 1 and 21, Boston teaches a method (see Figure 8 described in Col. 8 Lines 52-53) of and processor (see processor 3000 of Figure 30 described in Col. 25 Lines 10-15) for providing an advertisement in a communication channel, the method and processor operation comprising: receiving the advertisement for display on a television within a home (step 965 of Figure 9 described in Col. 10 Lines 2-4); display a notification of the advertisement on said television, after said receiving of the advertisement (highlighted selection 1420 of Figure 14, as described in Col. 13 Lines 37-39; with further reference to Col. 13 Lines 26-35); scheduling said received advertisement for viewing (step 945 of Figure 9 described in Col 9 Lines 58-61) on said television within said home; and displaying media corresponding to at least a portion of said scheduled advertisement (step 935 of Figure 9 described in Col. 9 Lines 55-58) on said television based on said scheduling.

10. In reference to claims 2 and 22, Boston teaches a method of and processor for presenting data representative of said received advertisement (Figure 12 described in Col. 12 Lines 18-20) in an available slot in a channel guide (detailed edit schedule 1200 of Figure 12 described in Col.12 Lines 4-12).

11. In reference to claims 3 and 23, Boston teaches a method of and processor for displaying data representative of said received advertisement where the advertisement is one or more of graphical data, textural data, audio data and video data (disclosed in Col. 2 Lines 56-65).

12. In reference to claims 4 and 24, Boston teaches a method of and processor for establishing a user profile (Figure 3 described in Col. 5 Lines 1-3) indicating at least a particular type of advertisement that is to be received (detailed edit schedules 610 described in Col. 6 Lines 60-63).

13. In reference to claims 5 and 25, Boston teaches a method of and processor for determining whether data representative of said particular type of advertisement is within said established profile (step 840 of Figure 8 described in Col.9 Lines 4-10); and if said data representative of said particular type of advertisement is within said established profile, receiving said particular type of advertisement (step 860 of Figure 8 described in Col.9 Lines 10-12).

14. In reference to claims 6 and 26, Boston teaches a method of and processor for identifying a gap that exists in a schedule in a channel guide (step 835 of Figure 8 described in Col 8 Lines 4-5) displayed on said television.

15. In reference to claims 7 and 27, Boston teaches a method of and processor for scheduling at least one advertisement for display at a time corresponding to said identified gap (decision 1040 of Figure 10 described in Col. 10 Lines 44-48).

16. In reference to claims 11, 12, 13, 14, 15, 16, and 17, Boston teaches a machine-readable storage having stored thereon, a computer program having at least one code section for providing an advertisement in a communication network (disclosed in Col. 25 Lines 16-25), the at least one code section being executable by a machine (disclosed in

Col. 25 Lines 25-27) for causing the machine to perform the method of claims 1 through 10, as rejected above.

17. In reference to claim 21, Boston teaches a system for providing an advertisement in a communication network (system diagram shown in Figure 6 as described in Col. 6 Lines 55-63).

18. In reference to claim 31, Boston teaches a processor that is a media management system processor (processor 3000 of Figure 30 disclosed in Col 24 Lines 1-5).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. Claims 8-10, 18-20, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al (US Patent 7,212,730) in view of Oh (US Patent Application Publication 2002/0161713).

21. In reference to Claims 8, 18, and 28 Boston does not teach a method for granting permission to schedule at least one advertisement for display within said identified gap. However, Oh, in a similar field of invention, teaches a method of inquiring from a user if

he/she will watch at least one of the advertisement contents presented (as disclosed in Paragraph 0047 Lines 1-3).

In view of Oh's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of advertisement insertion disclosed by Boston to incorporate a method of granting permission to schedule an advertisement for display to the user. It would be advantageous to have an advertising system that required the permission of the user to display a give advertisement because a user's interaction with the advertisement would suggest that the user has a true desire to view the advertisement and would therefore be more likely to view additional program content and related advertisements (as Oh describes in Paragraph 0011).

22. In reference Claims 9, 10, 19, 20, 29, and 30 Boston does not teach a method for offering a reward for scheduling the advertisement for display within a personal advertisement channel. In addition, Boston does not teach a method where said reward comprises at least one of free programming and reduced programming cost. However, Oh teaches a reward method of providing advertisement content to a user in which multimedia content prices are discounted in an incremental fashion dependent upon when the user elects to view the given advertisement (as disclosed in Paragraph 0054). In addition, if the user elects to view the advertisement while the multimedia content is being played, the system provides the said multimedia content for free (as disclosed in Paragraph 0054 Lines 8-12).

In view of Oh's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of advertisement insertion disclosed by Boston to incorporate a method discounting programming content based on the event of a user scheduling an advertisement to be viewed. It would be advantageous to have an advertising system that rewarded the user for scheduling an advertisement for viewing because the user would be more likely to view additional program content and related advertisements in exchange for free or reduced cost programming (as Oh describes in Paragraph 0011).

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. RYAN whose telephone number is (571)270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. A. R./
Examiner, Art Unit 2623
Tuesday, April 01, 2008

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2623